

REMARKS

A. INTRODUCTION

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81, 92-106 are pending and rejected.

Upon entry of this Amendment:

- Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81, 92-106 will be pending
- Claims 1, 42, 56, 60, 69, 71, 75, 81 and 92-95 will be amended
- Claims 1, 56, 60, 69, 71, 75, 81 and 92-95 will be the only independent claims

B. REQUEST FOR CONTINUED EXAMINATION

This paper is being filed in response to an Office Action mailed January 10, 2008. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of these remarks.

C. CLAIM 42 IS AMENDED

Claim 42 has been amended to clarify that one, not all, of the recited types of entities may provide the recited indication. No new matter has been added.

D. SECTION 112 ¶ 2 REJECTION: INDEFINITENESS

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which we regard as the invention.

We respectfully traverse the Examiner's Section 112 ¶ 2 rejection of Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106.

In particular, the Final Action at paragraph 3 alleges that the phrases "a subsidizer different from the at least one merchant" and the "third party entity different from the restaurant", which appear in the independent claims, are indefinite. In addition, the term "third party entity" was deemed to be arbitrary and readily changeable, even though it was recognized that: "The common meaning of "third party" is an entity that is independent of some other first and second parties" (Final Action, paragraph 4). Applicants submit the disputed claim language is reasonably precise on its face and when read in light of the Specification.

The Examiner appears to make two points of argument: (1) the ability of entities to change their ownership relationship means “third party entity” is imprecise; and (2) “different” must mean different in ownership.

1. “variable” business ownership

The first argument is easily addressed. The variability of “business ownership” is not fatal to the definiteness of any pending claim, any more than the variability of a preferred manufacturing process by a potential infringer would be fatal to the definiteness of a particular manufacturing process claim. The breadth of possibilities of hypothetical actions by hypothetical entities have no bearing on whether any specific hypothetical conduct can be reasonably determined to fall within or without the scope of a claim (i.e. whether a claim is definite or not). There is a scope defined by the claims that can be compared to different activities/relationships.

The Examiner’s example in paragraph 6 illustrates the point: the Examiner finds that if Wal-Mart buys a “third party” supplier, the supplier is no longer a third party—it “disappears”. (Applicants do not necessarily agree or disagree, but that is immaterial.) The Examiner cannot say that it is unreasonably difficult to ascertain whether a third party relationship exists, when the Examiner explicitly concludes it would not (i.e., according to the Examiner, there would be no infringement)—that is the epitome of definiteness. The Examiner goes on to hypothesize about a different type of relationship (discussed below), but the fact that relationships between entities may change over time is immaterial to whether the claim language is reasonably precise. All that is necessary is that, at any point in time, such entities could reasonably determine whether they were infringing, for example.

2. “different” must mean different in ownership

The Examiner’s second line of argument makes some assertions about how “different” must mean an “ownership limitation,” and subsequently suggests some 50% ownership scenarios to demonstrate the alleged imprecision of the claim language.

As a preliminary matter, Applicants disagree that “different” must mean an “ownership limitation.” “Different” means:

1. Unlike in form, quality, amount, or nature; dissimilar: *took different approaches to the problem.*
2. Distinct or separate: *That's a different issue altogether.*
3. Various or assorted: *interviewed different members of the community.*

4. Differing from all others; unusual: *a different point of view.*

"different." *The American Heritage® Dictionary of the English Language, Fourth Edition.* Houghton Mifflin Company, 2004. 10 Jul. 2008. <Dictionary.com <http://dictionary.reference.com/browse/different>>.

In short, the appropriate construction of "third party entity different from the restaurant," for example, is an entity that is not the same as, differs from, and is not in identity with the restaurant. Accordingly, it is not relevant that one entity may be a 25%, 50%, or 100% owner of another; so long as the entities are not the same, they are different.

Furthermore, each of claims 96-106 depend on one of the independent claims 1, 56, 60, 69, 71, 75, 81 and 92-95, and recites that the merchant is a restaurant (where applicable), and that the subsidizer (or third party entity) is at least one of an automobile dealership, a mortgage brokerage company, an investment company, an insurance company, a taxi service, a retailer, a department store, a magazine subscription company, a credit card provider, a telephone service provider or an internet service provider. Even though the Examiner affords that recited subject matter no patentable weight in distinguishing it from Chen (which Applicants dispute at least for the lack of any articulated argument to support the finding), such features clearly speak to a reasonably precise and discernable difference between the recited entities. Rejection of a base claim for indefiniteness does not per se mean that all dependent claims are indefinite (e.g., the dependent claim may clarify whatever imprecision is allegedly present); the rejection of Claims 96-106 is traversed for at least the reason that the claim limitations have not been addressed and consequently no prima facie case of indefiniteness can have been established for those claims.

Applicants respectfully request reconsideration and withdrawal of the Section 112(2) rejections.

E. SECTION 102(E) AND 103(A) REJECTIONS

Claims 1, 4, 8, 9, 13, 15-18, 20-23, 28-34, 36, 37, 39-64, 69-71, 75, 81 and 92-106 stand rejected under 35 U.S.C. 102(e) as being anticipated by Chen (U.S. Patent No. 6741969). Applicants respectfully traverse the Examiner's Section 102(e) rejection.

Claims 19, 24, 25 and 72-74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen. We respectfully traverse the Examiner's Section 103(a) rejection.

Applicants maintain the arguments provided in their previous response with respect to the independent claims, such as that Chen does not teach or suggest

offering a price adjustment for the plurality of products to a customer in exchange for that customer agreeing to perform a qualifying action that *concerns a product of the subsidizer*, and then *receiving an acceptance of the subsidy offer*, and *providing the price adjustment to the customer* (which pertains to the plurality of products, and not to the product of the subsidizer).

However, solely in order to expedite allowance of the present application, all of the pending independent claims (Claims 1, 56, 60, 69, 71, 75, 81 and 92-95) have been amended to recite desirable embodiments. No new matter has been added. Generally, the independent claims now specify wherein a subsidy offer/item/product is associated with a price adjustment on purchase of at least one item/product of at least one merchant/restaurant in a first transaction, and a qualifying action for the subsidy offer concerns a purchase of a product of a third party/subsidizer in a second (different) transaction.

For example, the Examiner asserts that Chen teaches a system in which a diner may receive a discount offer based on tracking of a customer paying for a meal (in a first transaction), the discount offer (e.g., on a competitor bottle of wine) being only for a discount on a subsequent purchase (a second transaction) that is not the same as the meal transaction. However, Chen does not teach or suggest, discounting the price of a restaurant meal (a first transaction), in exchange for the customer agreeing, for example, to purchase a competitor's bottle of wine (in a second transaction), much less that the competitor may subsidize the price of the meal. Accordingly, Chen does not teach or suggest all of the features of any of the pending claims.

Applicants respectfully request the Examiner's reconsideration and withdrawal of the Section 102(e) and 103(a) rejections, and allowance of the pending claims.

F. ADDITIONAL COMMENTS

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

G. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a three-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$1050.00

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H. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.

Respectfully submitted,

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